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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,690	03/29/2004	J. Christopher Marmo	1128-01-PA-TD	1370

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Klein, O'Neill & Singh, LLP
18200 Von Karman Avenue
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Irvine, CA 92612

EXAMINER

NUTTER, NATHAN M

ART UNIT	PAPER NUMBER
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1765

MAIL DATE	DELIVERY MODE
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12/29/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/811,690	Applicant(s) MARMO, J. CHRISTOPHER	
	Examiner Nathan M. Nutter	Art Unit 1765	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 172-178 and 186 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 172-178 and 186 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12-13-10</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 172-178 and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Froix (US 4,871,785) taken in combination with Krezanoski et al (US 3,954,644) and in view of Newman et al (US 2007/0000792).

The reference to Froix teaches the production of a contact lens material wherein the lens material is polymerized in the presence of a polyethylene oxide (WSP), as herein claimed. The contemplated monomers are taught at column 4 (lines 13-27) and include those disclosed in the instant Specification. The process is shown at column 7 (line 600 to column 8 (line 2) and the many Examples. Example 10 describes casting a film. Since the reference is drawn to contact lenses, it is easy to infer that the known method of casting would be employed in the production of the lenses, per se.

The reference to Krezanoski et al (US 3,954,644) show the storage and cleaning of contact lenses using polymers, as herein recited and claimed. The patent to Krezanoski et al shows the use of polyalkylene glycol polymers for storage and cleaning of contact lenses. Note the Abstract.

The reference to Newman et al (US 2007/0000792) shows a typical package for a contact lens, as herein claimed. Note the Figures 1-7 that show the package to possess a cavity structure.

Froix teaches the manufacture of the contact lens of the claims. Krezanoski et al shows the solutions for cleaning/storage using a polyalkylene glycol polymers and show such as conventional, as recited herein. As such, the use of the solutions for cleaning/storage with the contact lenses of either primary reference would have been a prima facie obvious modification, as being standard in this art. Contact lenses, especially hydrophilic lenses, are stored in liquid to prevent their drying out and becoming brittle and useless. The employment of a package, while notoriously obvious since the product must be vended and distributed, or stored prior to distribution, is shown by Newman et al. As such, a skilled artisan would have a high level of expectation of success following the teachings of the references. Nothing unexpected is shown. The recitation of "single use" provides no patentable distinction since it is intended to be used at least once. The recitation and the claim language of "comprising" does not exclude the use of the lens a multiple number of times, or that a multi-use lens may not be included in the "package system" recited.

Response to Arguments

Applicant's arguments filed 13 December 2010 have been fully considered but they are not persuasive.

With regard to the rejection of claims 172-178 and 186 under 35 U.S.C. 103(a) as being unpatentable over Froix (US 4,871,785) taken in combination with Krezanoski et al (US 3,954,644) and in view of Newman et al (US 2007/0000792), applicant argues Froix "discloses only compositions comprising either polyethylene oxide or polyethylene glycol having a sub-unit of (CH:CH:O). Froix does not disclose or suggest the use of any other polyalkylene glycols, such as polypropylene glycol, polyoxypropylene, or polybutylene glycol." The argument is not relevant since the claims are not directed to any particular "water soluble polymer component." Certainly, no such species are recited in the claims. The disclosure of Froix is sufficient to meet the language of the claims. Applicant, then, posits "Froix makes clear that the desirable properties of Froix's lenses are attributable not to polypropylene oxide, polybutylene glycol, or any other polyalkylene glycols but specifically to polyethylene glycol or polyethylene oxide units." Again, it is pointed out to applicant, the instant claims do not recite any named species, and the reference teachings are sufficient to meet the claim language. With regard to Krezanoski et al, applicant opines the reference "does not disclose or suggest any polymers or copolymers other than the polyoxypropylene-polyoxyethylene block copolymers." The disclosure of the reference is sufficient to meet the claim language of "a polyalkylene glycol." Applicant further purports that since the reference discloses "a user needs to: (1) rinse the lenses with water: and (2) boil the lenses in normal saline." The reference teaches the "regimen" as a "typical regimen." Contact lens wearers are well-aware of steps necessary for the comfort of their lens wearing. Regardless, the instant claims do not exclude any of these steps, or others not stated. Further, it is

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pointed out that the reference is relied upon for the art-recognized use of a contact lens cleaning solution. It would be common sense that one would desire the lens to be sterile prior to placement in the eye. The reference shows the solution employed for sterilization. The rejection stands for the reasons given. It is pointed out that regardless of whether the lens is a one-use only product, or a multi-use contact, lost on its first use, the claims do not differentiate over the references for the reasons given. The breadth of the instant claims does not warrant applicant's narrow and specific interpretations thereof. The claims are viewed in their broad context.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1765

nmn

16 december 2010